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| 09/607,605 | 06/30/2000 | Kia Silverbrook | NPA065US | 8541 |

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AUSTRALIA

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| EXAMINER |
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FILIPCZYK, MARCIN R

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| ART UNIT | PAPER NUMBER |
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2171

DATE MAILED: 05/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,605

Applicant(s)

SILVERBROOK ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

This Action is responsive to Applicant's response filed on March 16, 2003 (paper # 6).

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-18, 22-25, 27-29, 34-38, 40, 41, 43, 44, 46-57, 61-64, 66-71, 73, 74, 76, 77, 79-92, 96-99, 101-108, 110, 112 and 113 are rejected under 35 U.S.C. 102(e) as being anticipated by Escallon (U.S. Patent No. 5,799,157).

Regarding claims 27, 29, 44, 61, 66, 73, 77, 101 and 113, Escallon discloses a system for enabling access to travel services, the system including, (see title)

a form containing information relating to a travel service transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form; (fig. 1, 140 and, col. 5, lines 49-54), and

a computer system for receiving indicating data (fig. 1, block 10) from a sensing device for identifying at least one parameter relating to the travel service transaction, the indicating data being indicative of the identity of the form and a position of the sensing device relative to the form (fig. 1, 110), the sensing device sensing the indicative data using at least some of the coded data (fig. 1, 110); and

identifying in the computer system and from the indicating data, at least one parameter relating to the travel service transaction (fig. 1, block 142).

Regarding claim 28, Escallon discloses one parameter relating to the travel service transaction is associated with at least one zone of the form (col. 5, lines 49-57).

Regarding claims 34, 67 and 104, Escallon discloses at least one parameter of the travel service transaction is selected from a group comprising an action parameter of the travel services transaction (fig. 3, blocks 301, 320, 330).

(Note: fulfilling transaction requests)

Regarding claims 35-38, 68-71 and 105-108, Escallon discloses multiple parameters of travel service transactions (see col. 3, lines 1-14).

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Regarding claims 41, 74 and 110, Escallon discloses all of the claimed subject matter as discussed above with respect to claim 27 including improvements over more traditional methods such as the use of printed media (see col. 1, lines 39-47).

Regarding claims 43, 76 and 112, Escallon discloses a database for keeping a retrievable record of each form generated, each form being retrievable by using its identity as included in its coded data (col. 4, lines 26-40).

Regarding method claims 1-3, 8-18, 22-25, 46-57, 62-64, 79-92 and 96-99 contain same subject matter as the system claims respectively and therefore are rejected under 35 U.S.C. 102(e) on the same basis as the claims above as anticipated by Escallon (U.S. Patent No. 5,799,157).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 72 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Suda et al (U.S. Patent No. 6,157,465).

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Regarding claim 39, 72 and 109, Escallon discloses all of the claimed subject matter as discussed above with respect to claims 27, 66 and 101, but does not teach the sensing device includes a marking nib.

However, Suda discloses a system for transferring jobs between processing units for which he uses a (e-pen) marking device (fig. 6, 605, Suda). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an e-pen in Escallon system as used in Suda system to enter data into forms without using a keyboard. The motivation for one of ordinary skill in the art to use an e-pen would have been the convenience and flexibility of entering data to fill out forms without the use of a keyboard.

Claims 19-21, 26, 42, 45, 58-60, 65, 75, 78, 93-95, 100, 111 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Wilz Sr. et al (U.S. Patent No. 5,992,752).

Regarding claims 19-21, 26, 42, 45, 58-60, 65, 75, 78, 93-95, 100, 111 and 114, Escallon discloses all of the claimed subject matter as discussed above with respect to claims 27, 66 and 101, but does not expressly teach printing forms.

However, Wilz discloses an internet based system for enabling information-related transactions over the internet (title, Wilz) in which printing of coded transactions takes place (fig. 1, item 39, Wilz). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to print part coded forms in Escallon as done in Wilz by using a

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printer in conjunction with a computer. One of ordinary skill in the art would have been motivated to print forms to retain a physical copy of a transaction for record.

Response to Arguments

Applicant's arguments filed on March 16, 2003 have been fully considered but they are not persuasive. The Applicant's arguments of the 3/16/2003 response and Examiners answers are listed below.

Argument:

Regarding all the independent claims which Examiner suggested indefinite, Examiner asked, "How does any sensing device sense its own movement by itself?" and "How and where is the sensing device maneuvered?" Claim one specifies that the sensing device senses the coded data "when placed in an operative position relative to the form." The sensing device may be placed in this operative position by any number of ways or means.

Response:

Examiner disagrees. Examiner quotes Applicant, "The sensing device may be placed in this operative position by any number of ways or means". This is a broad explanation taking into account that this is what the Applicant considers to be inventive. Hence, a general interpretation based on the claimed language is made.

Argument:

Machine code is not like the claimed coded data which is adapted to be sensed by the sensing device.

Response:

Examiner disagrees. Abstract, lines 12 and 13, Escallon discloses forms are coded.

Argument:

Escallon does not disclose:

1. a sensing device
2. coded data which is indicative of "an identity of the form", "at least one reference point of the form" or "at least one parameter of the travel service transaction."

Response:

Examiner disagrees. Transaction management server 220 of Escallon is a sensing device. Regarding the coded data, Examiner points out that most electronic forms contain coded data as the form's identifier. In fig. 1 of Escallon system, an electronic book 100 keeps track of all the electronic forms 140. Col. 4, lines 30 and 31 further disclose each forms placeholder 142 has an associated variable name.

Argument:

The barcodes in Wilz do not anticipate the claimed coded data because they are not indicative of "an identity of the form", at least one reference point of the form" or "at least one parameter of the travel service transaction."

Response:

Examiner disagrees. Wilz system discloses a scanning device, programmable decoder, code string synthesizer with a code generator module and data transmission (fig. 1B3, Wilz) which scan and process documents (fig. 1, Wilz). Hence, Wilz alone anticipates coded forms.

Conclusion

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Regarding all new claims in the non-multiple-dependent format, Examiner notices additional submitted claims and notes that all the rejected claims are mapped to as best as the Examiner is able to ascertain to expedite the process of examining the application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MF

May 9, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100